

REMARKS

I. Status of the Claims

Claims 1-92 are pending in this application and stand rejected. Claims 1, 83, 88, and 92 have been amended to recite that the “at least one associative polymer [is] chosen from anionic, cationic and amphoteric associative polymers.” Support for this amendment can be found in canceled claim 7 and throughout the specification as filed. See paras. [018]-[0173].

Applicants note that, as amended, claims 1, 83, 88, and 92 no longer recite non-ionic associative polymers. Applicants have chosen to claim less than the full scope of their disclosure – a legitimate procedure for inventors entitled to decide the bounds of protection they seek. See, e.g., *In re Johnson*, 558 F.2d 1008 (C.C.P.A. 1977). Accordingly, no new matter has been introduced by the present amendment.

Claim 8 has been amended to correct dependency.

Claims 7 and 21-25 have been canceled without prejudice or disclaimer.

Applicants respectfully submit that no new matter has been introduced by the present amendment, nor does the amendment raise new issues or necessitate the undertaking of any additional search of the art by the Examiner..

II. Claim Rejections

A. Cottard in view of Sokol

The Examiner has rejected claims 1-30 and 42-92 as unpatentable under 35 U.S.C. § 103(a) over U.S. Patent Application Publication No. 2001/0023514 A1 to Cottard et al. (“*Cottard*”) in view of U.S. Patent No. 3,836,326 to Sokol et al. (“*Sokol*”) for the reasons disclosed on pages 2-5 of the Office Action. Applicants respectfully traverse this rejection.

In the Office Action, the Examiner contends that *Cottard* teaches all the claim limitations recited in claims 1-30 and 42-92 with the exception of a C₁₄-C₃₀ alkyl sulphate. See *Office Action*, page 4. To remedy this failing, the Examiner relies on *Sokol*, the secondary reference, alleging that it would have been obvious to modify *Cottard* by incorporating the sodium myristyl sulfate taught by *Sokol*. According to the Examiner, this proposed modification would have been obvious because *Cottard* suggests the use of the alkyl sulfate genus in a hair dyeing composition. *Id.* Thus, the Examiner alleges, one skilled in the art “would be” motivated to incorporate the alkyl sulfates as taught by *Sokol*. *Id.* Applicants disagree for the reasons discussed in detail below.

1. No Motivation to Combine The Cited References

First, simply because both *Cottard* and *Sokol* generally relate to hair dyeing compositions does not, by itself, mean that one skilled in the art would have combined the two. To properly combine two references, the prior art must suggest the desirability of the claimed combination. i.e. the prior art must show that the invention was worth seeking or that it would have somehow been advantageous. M.P.E.P. § 2143.01. Simply put, the prior art must provide some motivation or incentive to combine the teachings of the cited references.

Evidence of a motivation or suggestion can come from three sources: (1) the teachings of the prior art; (2) the nature of the problem to be solved; and (3) the knowledge of one skilled in the art. *Id.* Here, the Examiner relies on the teachings of the prior art and the knowledge of one skilled in the art. But this reliance is misplaced.

Turning to the primary reference - *Cottard* - the Examiner contends that this reference teaches the use of alkyl sulfates in dyeing compositions. *Office Action*, page 4. To support this contention, the Examiner points to the disclosure of alkyl sulfates embedded in a laundry list of surfactants in *Cottard*. *Para.* 0321. Although this disclosure may illustrate that alkyl sulfates can be used as surfactants in a dyeing composition, it provides no suggestion that any species within this genus would be beneficial, or even somehow advantageous in creating a dyeing composition.

Indeed, because the alkyl sulfate genus is only mentioned as an optional ingredient, one skilled in the art would not have had a reason to select it. The *Cottard* inventors were primarily concerned with finding an alternative thickening system for dyeing compositions. *Para.* 0007. They discovered that by combining (1) at least one oxidation dye; (2) at least one thickening polymer comprising at least one fatty chain; and (3) at least one particular fatty alcohol, they could obtain a dyeing composition that resisted running and remained confined to the site of application. *Paras.* 0007-0008. Surfactants, such as alkyl sulfates, are mentioned in the *Cottard* disclosure as optional ingredients. *Para.* 0317. And nothing in *Cottard* suggests that these optional surfactants facilitated the inventors' search for an alternative thickening system. Thus, given the nature of the problem the inventors sought to solve, there would have been no reason to select alkyl sulfates over any other listed surfactant, or at all.

Moreover, *Cottard* discloses hundreds of possible optional surfactants that can be used in its inventive dye compositions. *Para.* 0317 - *para.* 0338. From these hundreds of surfactants, the Examiner proposes that it would have been obvious to select alkyl sulfates. In view of the fact that there is no teaching or even a suggestion to

select alkyl sulfates, the disclosure of a laundry list of surfactants cannot be used as a basis for an obviousness rejection.

Sokol has similar failings. This reference also only discloses the optional use of certain alkyl sulfates in its dye compositions. Specifically, it discloses that “dispersions of the various ingredients can be accelerated by the addition of a detergent of dispersing agent such as sodium lauryl sulfate or sodium myristyl sulfate, triethanolamine lauryl sulfate, etc.” Col. 4, lines 59-63. But nothing in this reference provides any suggestion to use sodium myristyl sulfates as opposed to the other two alkyl sulfates disclosed.

All that can be concluded from *Sokol* and *Cottard* is that it was known at the time of Applicants’ invention to use various types of surfactants in a dyeing composition. But there is no suggestion in either reference that one skilled in the art would have selected sodium myristyl sulfate to replace any surfactant, let alone, the alkyl sulfates generally disclosed in *Cottard*. When viewed as a whole, neither *Cottard* nor *Sokol* provide any suggestion that the modification suggested by the Examiner would have resulted in an advantageous rather than disastrous dye composition. Rather, in both references the alkyl sulfates are referred to in passing and not in any way that would provide the requisite motivation or suggestion to combine teachings of the two references. Desirability requires much more than a mere mention in a document or acknowledgment that each claim limitation is known. M.P.E.P. § 2143.01. Accordingly, for at least the above reasons, the rejection should be withdrawn.

2. The Disclosure of a Genus Does not Render Obvious all Species That Fall Within it

Second, the disclosure of a genus does not render obvious every species that so happens to fall within it. M.P.E.P. § 2148 II (“The fact that a claimed species or subgenus is encompassed by a prior art genus is not sufficient by itself to establish a prima facie case of obviousness). An Examiner must still make specific factual findings that establish that the prior art suggested the claimed compounds. *Id.* The Examiner, however, has made no such findings in the present case.

Instead, the Examiner merely relies on the knowledge of one skilled in the art as evidence that the prior art suggested the use of sodium myristyl sulfates. The Examiner contends that “the ordinary artisan would have the reasonable expectation that any species of the genus would have similar properties.” *Office Action*, page 4. But the Examiner provides no reason as to why one skilled in the art would have this expectation. He simply relies on the “ordinary artisan” as a short-cut means to establish a prima facie case of obviousness.

The M.P.E.P. makes clear, however, that motivation to make the claimed invention must arise from the objective evidence of the record. Moreover, as the Examiner knows, “[t]he level of skill in the art cannot be relied upon to provide the suggestion to combine references.” M.P.E.P. § 2143.01 (citing *Al-Site Corp. v. VSI Int’l Inc.*, 50 USPQ2d 1161 (Fed. Cir. 1999)). In *Al-Site*, the Federal Circuit rejected an obviousness argument where there was no “specific teaching or suggestion for making [the proposed] combination” and held that “[s]kill in the art does not act as a bridge over gaps in substantive presentations of an obviousness test, but instead supplies the primary guarantee of objectivity in the process.” *Al-Site* at 1171. Thus, the Examiner

must provide objective evidence that the prior art suggests that the selection of sodium myristyl sulfates would have been obvious in view of a teaching of the alkyl sulfate genus. The Examiner has failed to do so here. Accordingly, for at least this additional reason the rejection should be withdrawn.

B. Rejection of Claims 16-17, 22, and 41-42

Because *Cottard* fails to teach the presently claimed weight ratios for the associative polymers and alkyl sulfates (claims 44 and 45), the Examiner contends that these ratios still would have been obvious because *Cottard* teaches the weight amounts for the associative polymers and *Sokol* teaches the weight amounts for sodium myristyl sulfate. *Office Action*, page 5. Applicants respectfully traverse this rejection.

As discussed above, one of ordinary skill in the art would not have been motivated to combine the teachings of *Cottard* and *Sokol* in the first place. Moreover, the Examiner again improperly relies on the knowledge of one skilled in the art in lieu of concrete evidence supporting the obviousness of the claimed invention. Accordingly, the rejection of these claims is also improper and should be withdrawn.

2. Cottard in view of Sokol and further in view of Laurent

The Examiner has also rejected claims 31-41 under 35 U.S.C. § 103(a) as unpatentable over *Cottard* in view of *Sokol* and further in view of U.S. Patent Application Publication No. 2002/0046431 to Laurent et al. ("*Laurent*") for the reasons disclosed on pages 5-6 of the Office Action. Applicants respectfully traverse this rejection.

The Examiner notes that *Cottard* and *Sokol* fail to teach the claimed cationic amphiphilic polyurethane polymers. *Office Action*, page 5. But, according to the Examiner, *Cottard* suggests the use of associative cationic polymers and *Laurent*

teaches a cationic polyurethane similar to the one presently claimed. *Id.* Thus, according to the Examiner, it would have been obvious to one of ordinary skill in the art to have modified *Cottard* by incorporating *Laurent's* cationic polyurethane because of their respective teachings. *Id.* Applicants disagree.

First, even when all the cited references are viewed together, the cited references fail to render claims 31-41 obvious. As discussed above, one of ordinary skill in the art would not have been motivated to combine the teachings of *Cottard* and *Sokol*, and *Laurent* as relied on by the Examiner for its alleged teaching of cationic polymers, fails to cure the fundamental deficiencies of the underlying references and thus cannot render the claimed invention obvious.

Second, the Examiner again improperly relies on the knowledge of one skilled in the art to make out the rejection by contending it would have been obvious to one of ordinary skill in the art to have modified *Cottard* by incorporating *Laurent's* cationic polyurethane. The Examiner's rationale is so broad that it would encompass essentially the modification of any composition by adding any cationic polymer of *Laurent* for any purpose or no purpose at all. This logic is contradictory to the Federal Circuit's holdings with respect to combining old elements, because the Examiner is taking the position that the combination of known elements is *prima facie* obvious. *In re Kotzab*, 55 USPQ2d 1313, 1316 (Fed. Cir. 2000) ("[m]ost if not all inventions arise from a combination of old elements.... However, identification in the prior art of each individual part claimed is insufficient to defeat patentability of the whole claimed invention). Thus, for at least the foregoing reasons, Applicants respectfully request that this rejection also be withdrawn.

CONCLUSION

In view of the foregoing remarks, Applicants respectfully request reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: June 2, 2006

By: Mareesa A. Frederick
Mareesa A. Frederick
Reg. No. 55,190